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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,350	10/19/2006	Devin Leake	16542.16.1a.3	3238
22913 7590 06/16/2008 WORKMAN NYDEGGER 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111				
EXAMINER				
BOWMAN, AMY HUDSON				
ART UNIT		PAPER NUMBER		
1635				
MAIL DATE		DELIVERY MODE		
06/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,350

Applicant(s)

LEAKE ET AL.

Examiner

AMY H. BOWMAN

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 201-203, 205-209, 211, 213, 214, 220, 221, 224-228 and 230-236 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 201-203, 205-209, 211, 213, 214, 220, 221, 224-228, and 230-236 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Instant claims 201-203, 205-209, 211, 213, 214, 220, 221, 224-228, and 230-236 are directed to a multitude of types of modifications as well as specific configurations of combinations of the modifications. Applicant is required to elect one specific species of the invention for examination. Specifically, applicant is required to elect one species of modifications or one specific combination of the instantly recited modifications, as well as one specific configuration of the modifications, for examination.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

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- Claims 201 and 202, claim 213 **or** 214, claims 220 and 221 (with an election of either phosphorothioate or methylphosphonate linkage consistent with claims 213 or 214), and claims 224-227)
- Claims 201-203, claim 213 **or** 214, claims 220 and 221 (with an election of either phosphorothioate or methylphosphonate linkage consistent with claims 213 or 214), and claims 224-227)
- Claims 201, 202, 205, claim 213 **or** 214, claims 220 and 221 (with an election of either phosphorothioate or methylphosphonate linkage consistent with claims 213 or 214), and claims 224-227)
- Claims 201, 202, 206, claim 213 **or** 214, claims 220 and 221 (with an election of either phosphorothioate or methylphosphonate linkage consistent with claims 213 or 214), and claims 224-227)
- Claims 201, 202, 206, 207, claim 213 **or** 214, claims 220 and 221 (with an election of either phosphorothioate or methylphosphonate linkage consistent with claims 213 or 214), and claims 224-227)
- Claims 201, 202, 208, claim 213 **or** 214, claims 220 and 221 (with an election of either phosphorothioate or methylphosphonate linkage consistent with claims 213 or 214), and claims 224-227)
- Claims 201, 202, 209, 211, claim 213 **or** 214, claims 220 and 221 (with an election of either phosphorothioate or methylphosphonate linkage consistent with claims 213 or 214), and claims 224-227)

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Each of the specific types of modifications are structurally distinct. Each of the specific combinations of modifications represents a separate and distinct embodiment of the invention. Furthermore, each of the specific configurations of modifications that specify particular locations within the duplex for the modifications to be placed is considered a separate and distinct species of the invention, as each resultant molecule is structurally distinct and requires a separate search and corresponding examination.

Furthermore, there is no unity of invention as there is no special technical feature linking the groups, as Giese et al. (US 2004/0180351 A1) teach functional synthetic siRNA molecules comprising a sense and antisense strand wherein the first and second nucleotides counting from the 5'-end of the sense strand are modified with 2'-O-alkyl

modifications, as required by instant claim 201 (see figure 10 of Giese et al., for example). Therefore, the technical feature linking the claims does not make a contribution over the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMY H. BOWMAN whose telephone number is (571)272-0755. The examiner can normally be reached on Monday-Thursday 6:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on (571) 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amy H. Bowman/

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